

REMARKS

Claims 1-17 are pending in the application. Claims 12-15 have been cancelled by this amendment. Claims 18-24 have been added. Therefore, claims 1-11 and 16-24 are at issue.

The specification has been amended to identify trademarks and tradenames by the use of capitalization. The specification also has been amended to correct an obvious typographical error in the identification of a U.S. patent publication. The publication was correctly cited in the Information Disclosure Statement (IDS) filed on October 4, 2004, and considered by the examiner, as U.S. Patent Publication No. 20010037006.

Independent claims 1, 16, and 17 have been amended to recite particular modified glycerols and to provide a structure for the hydrophilic copolymer/terpolymer. Support for these amendments can be found in the specification at page 3, lines 5-9 and lines 20-21. Claim 5 has been amended to identify HEMA and HBA and to improve the form of the claim. Support can be found in the specification at page 3, lines 9 and 10. Claims 7 and 8 also have been amended to improve the form of these claims.

New claims 18-24 are fully supported in the specification, for example, at page 2, line 34; page 3, line 11 and lines 20-22; page 4, lines 10-13; page 4, line 31 through page 5, line 10; page 6, lines 31-32; page 7, lines 19-22; and original claim 15.

In the Office Action, the examiner notes that a publication by Rixxi et al. in *Cosmetic News* (cited in the IDS of October 4, 2004) was not considered because a year of publication was not provided. Applicants therefore submit a Supplementary IDS concurrently with this amendment citing the Rixxi et al. publication with its year of publication. A copy of the publication was previously submitted and has not been resubmitted.

The examiner notes that a trademark used in page 5 of the specification should be capitalized. In response, applicants have amended the specification to capitalize trademarks and tradenames.

Claim 5 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to distinctly define HEMA and HBA. Applicants have amended claim 5 to identify these compounds and overcome this rejection. In addition, the specification has been amended to properly identify the U.S. Patent Publication that discloses the preparation of poly HEMA/HBA. Accordingly, it is submitted that claim 5 fully complies with 35 U.S.C. §112, and that the rejection should be withdrawn.

Claims 1-11 stand rejected under 35 U.S.C. §103 as being obvious over a combination of Torgerson et al. U.S. Patent No. 5,980,878 ('878) in view of Okuno et al. U.S. Patent No. 6,607,718 ('718). The basis of this rejection is that the '878 patent discloses a topical skin care composition containing poly HEMA/HBA and the '718 patent teaches a glyceryl ether, thereby rendering the present claims obvious to a person skilled in the art. Applicants traverse this rejection.

A determination that a claimed invention is obvious under §103(a) is a legal conclusion involving four factual inquiries: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any, of non-obviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the claimed subject matter pertains, who is presumed to have all prior art references in the field of the invention available to him/her. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Furthermore, obviousness must be determined as of the time of the invention was made and in view of the state of the art that existed at that time. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-51 (Fed. Cir. 1988).

The Patent Office "has the burden under §103 to establish a prima facie case of obviousness." *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988); MPEP §2142 (8th Ed., Rev. 6, Sept. 2007) ("The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness."). The Supreme Court recently identified a number of rationales that may be used to support a conclusion of obviousness, consistent with the framework set forth in its decision in *Graham v. John Deere Co.* See *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739-40 (2007). These and other representative rationales are

described at MPEP §2143 (8th Ed., Rev. 6, Sept. 2007). Regardless of the supporting rationale, however, the Patent Office must clearly articulate facts and reasons why the claimed invention "as a whole" would have been obvious to a hypothetical person having ordinary skill in the art at least as of the claimed invention's effective filing date. See *KSR Int'l*, 127 S.Ct at 1741 (citing with approval *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.")); see also MPEP §2143 ("The key to supporting any rejection under 35 USC §103 is the clear articulation of reason(s) why the claimed invention would have been obvious.").

To reach a proper determination under 35 U.S.C. §103(a), the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to the person. Knowledge of applicants' disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search, and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicants' disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the *facts* gleaned from the prior art. MPEP §2142.

The examiner is also reminded of a May 3, 2007 memorandum from the Deputy Commissioner for Patent Operations, which stated at page 2 (emphasis in original):

"(4) The Court noted that the analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit, and that it was "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. The Court specifically stated:

Often, it will be necessary...to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in

order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit**.

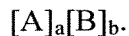
KSR, slip op. at 14 (emphasis added).

Therefore, in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed."

The present invention is directed to transfer-resistant cosmetic compositions, and particularly lip cosmetics, that provide a thin, durable film which resists degradation over time. In particular, the film resists transfer upon contact with clothing, towels, cups, handkerchiefs, tissues, and similar objects. The present compositions overcome problems associated with prior transfer resistant cosmetic compositions, such as an undesirable tight feeling on the lips, while providing a freshly applied, consistent look of high gloss and shine.

These improved results in a cosmetic composition are achieved by utilizing a hydrophilic copolymer/terpolymer, as presently claimed, in combination with a glycerol and a polar volatile solvent. The composition is applied to the skin, and particularly the lips, and allowed to dry by evaporation of the polar volatile solvent. The remaining film is durable, transfer resistant, shiny, and glossy.

The '878 patent discloses compositions useful for hair styling purposes and for the delivery active ingredients to or through the skin. In particular, the '878 patent is directed to a copolymer that provides the hair care and active delivery benefits. The disclosed copolymer contains random repeating A and B units, and has a formula:



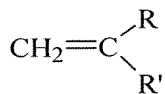
See specification, '878 patent, column 2, lines 38 *et seq.*

Monomer B is a hydrophilic *macromonomer*, i.e., a monomer already containing polymerized repeating units prior to copolymerization with monomer A, i.e., see the integer "m" in each disclosed B monomer. In particular, the '878 patent discloses five

separate classes of B macromonomers at columns 2 and 3. The first, second, and fifth classes of compounds are polyamides having a copolymerizable moiety. The third class is a polyether having a copolymerizable moiety, and the fourth class contains a polymerized moiety having a plurality of groups P and a copolymerizable moiety. A presently claimed hydrophilic polymer does not contain a macromonomer B of the '878 patent.

The copolymers of the '878 patent are different in structure from a presently claimed hydrophilic polymer. The presently claimed polymers contain 2-hydroxyethyl methacrylate (HEMA) monomer units and 4-hydroxybutyl acrylate (HBA) monomer units. The HEMA monomer units fall within the definition of the A monomer of the '878 polymer, i.e., $x=2$ -hydroxyethyl, R^5 =methyl, and R^6 =hydrogen. The HBA monomer does *not* fall within the definition of the A monomer of '878 patent, i.e., x in '878 cannot be 4-hydroxybutyl. The HBA monomer also does not fall within the definition of the *macromonomer* B disclosed in the '878 patent.

The claimed polymers also optionally can contain a third monomer, i.e.,



. As claimed, this monomer can be absent ($x=0$) or can be present ($0 < x \leq 100$). The R group of this monomer is CH_3 or H, and the R' group is aliphatic, aromatic, carboxy acid, carboxy ester, amide, hydroxyl, or amine. This optional monomer also does not fall within the definition of the *macromonomer* B disclosed in the '878 patent.

Contrary to the examiner's statement that the '878 patent discloses a poly-HEMA/HBA, the '878 patent fails to teach or suggest *any* polymer that is similar to a presently claimed hydrophilic copolymer/terpolymer. A presently claimed copolymer/terpolymer *fails* to include a macromonomer B, which is an essential component in the invention of the '878 patent.

The present claims recite a copolymer, e.g., of HEMA and HBA, of which only the HEMA falls within the scope of monomer A of the '878 patent. HBA does not fall within the scope of monomer A or macromonomer B of the '878 patent. Furthermore, *no*

monomer of a copolymer or a terpolymer, as presently claimed, contains a monomer B that is an essential component of the '878 patent invention.

The '878 patent is specific and clear with respect to the copolymer that is included in the disclosed composition. This copolymer is different from the presently claimed copolymer/terpolymer, and the '878 patent provides no suggestion to modify the structure of the disclosed copolymer and provide a presently claimed copolymer/terpolymer. In particular, the '878 patent *requires* a polymer of structure $[A]_a[B]_b$. A copolymer of the present invention (i.e., $x=0$) contains *only* an A monomer disclosed in the '878 patent and the second monomer (i.e., HBA) is not disclosed in the '878 patent. A terpolymer of the present invention, (i.e., $0 < x \leq 100$) also contains *only* an A monomer disclosed in the '878 patent and the second and third monomers are not disclosed in the '878 patent.

A person skilled in the art, after reading the '878 patent, would have had no apparent reason to alter the structure of the disclosed polymer in a manner that would lead to the presently claimed copolymer/terpolymer with any reasonable expectation of providing a transfer resistant film on a contacted surface. The '878 patent, to the contrary, teaches that the compositions can deliver an active agent *through* the skin. This is exactly an effect the present invention is designed to avoid.

Not only does the '878 patent fail to teach or suggest a presently claimed hydrophilic polymer, the '878 patent also fails to teach a presently claimed glycerol. In particular, the '878 patent fails to teach or suggest glycerol, a glycerol ether, or a glycerol ester, and it also fails to suggest including such a component in a disclosed composition.

It also must be stressed that contrary to the statement made by the examiner, the '878 patent does not disclose, or remotely suggest, generically or specifically, a poly-HEMA/HBA copolymer. The examples of the '878 patent, and the disclosure of the '878 patent, fails to teach or suggest a combination of hydrophilic polymer, glycerol, and polar volatile solvent, as presently claimed.

The '718 patent fails to overcome the deficiencies of the '878 patent. The '718 patent is relied upon solely for a disclosure of a glyceryl ether.

The '718 patent is directed to a hair cosmetic composition comprising:

"A composition that is suitable for treating hair includes: (A) 40 to 98 wt. % of a polyhydric alcohol; (B) at least one component, soluble in component (A), selected from the group consisting of a fat, an oil, a nonionic surfactant, a cationic surfactant, a higher alcohol, a hydroxycarboxylic acid, a dicarboxylic acid, an aromatic carboxylic acid, urea, guanidine and an aromatic alcohol and mixtures thereof; (C) 0 to 20 wt. % of water; and (D) 0.3 to 10 wt. % of hydroxypropyl cellulose." (abstract, '718 patent)

Note that the '718 patent lists eleven classes of compounds for component (B), one of which is a nonionic surfactant. As demonstrated by this list of compound classes disclosed in the '718 patent as useful as component (B) class, the compounds differ significantly in structure.

The '718 patent also lists a vast number of specific component (B) compounds at column 2, line 18 through column 3, line 12. Among the component (B) compounds are nonionic surfactants having a low HLB value of 10 or less.

It is submitted that a combination of the '878 and '718 patents does not render the present claims obvious. In particular, (a) the references fail to teach each and every claimed element, (b) the references provide no apparent reason to modify their combined teachings, and (c) there is no reasonable expectation that modifying the references as suggested by the examiner would provide a composition that is transfer resistant and exhibits esthetic properties.

The Office Action supports the obviousness rejection of the present claims using a rationale that all of the features/elements recited in the rejected claims were known in the prior art, and that an ordinarily skilled artisan could have combined those known features/elements, as claimed, by known methods with no change in their respective functions to yield predictable results.

However, the applied prior art does *not* disclose each and every claimed element. Specifically, the '878 patent fails to teach or suggest the claimed hydrophilic polymer, either generally or specifically. The reference also provides no motivation for a person skilled in the art to modify the teachings of the '878 patent and thereby arrive at the

presently claimed hydrophilic polymer. For example, the '878 patent teaches that monomers A and B are essential. The present hydrophilic polymer lacks a macromonomer B and optionally can include a third monomer that is not disclosed in the '878 patent. Rather than suggesting a presently claimed hydrophilic polymer to a person skilled in the art, the '878 patent teaches *away* from the claimed hydrophilic polymer. The asserted rationale supporting the present obviousness rejection, therefore, does not apply. See MPEP §2143 (A).

With respect to the '718 patent teaching a glyceryl ether, and the purported obvious inclusion of a glyceryl ether into a composition of the '878 patent, the rejection still fails for the reasons set forth above. Further, the '878 patent fails to provide any suggestion that a glyceryl ether should be included in a '878 composition. In addition, the Office Action fails to articulate a reason why a person skilled in the art would select a glyceryl ether from the large number of compound classes and specific compounds disclosed in the '718 as a component B. The reference provides no apparent reason for a person skilled in the art to select glyceryl ether from all the disclosed components B.

The examiner's entire basis for combining the references is that both are directed to cosmetic compositions, that individual claimed ingredients have been disclosed in the cited references (which is incorrect as discussed above), and therefore, the claims would have been obvious. This is a classic case of a hindsight reconstruction of the claims. The mere fact that applied art can be modified does not render the resultant combination obvious unless there is an apparent reason to modify the reference, unless the modification makes common sense, and unless the results would have been predictable to the ordinary skilled artisan. See *KSR Int'l*, 127 S.Ct. at 1740. Furthermore, it is incumbent that the cited art to teach *all* claimed elements, which is not the case in this rejection.

Accordingly, it is submitted that claims 1-11, and new claims 18-22, would not have been obvious under 35 U.S.C. §103 over a combination of the '878 and '718 patents, and that the rejection should be withdrawn.

Claims 16-18 stand rejected under 35 U.S.C. §103 as being obvious over Bolich, Jr. et al. U.S. Patent No. 5,965,115 ('115) in view of the '878 and '718 patents. It is submitted that the Office Action contains a typographical error because we claim 18 was on

file at the time of issuing the Office Action. Accordingly, the rejection is properly directed to claims 16 and 17, and applicants traverse the rejection.

The basis of the rejection is that the '115 patent teaches personal care compositions, including a lipstick, and modified sulfur-linked silicone copolymers. The '878 and '718 patents are relied upon for the same reasons stated in the rejection of claims 1-11.

Claims 16 and 17 recite a lip cosmetic kit comprising (I) a cosmetic composition identical to that recited in claim 1 and (II) a polymer vegetable oil emollient (claim 16) or a silicone modified fluorinated polymer (claim 17).

First, it is submitted that claims 16 and 17 are patentable over a combination of the '115, '878, and '718 patents for the same reasons claims 1-11 are patentable over a combination '878 and '718 patents. Component (I) of claims 16 and 17 is nonobvious over the '878 and '718 patents for the reasons set forth above. The '115 patent is directed solely to component (II) of claims 16 and 17 and adds nothing to the teachings of the '878 and '718 patents with regards to component (I). Therefore, for this reason alone, claims 16 and 17 would not have been obvious over a combination of the '115, '878, and '718 patents.

With respect to the '115 patent, the reference is directed to silicone emulsion for use as a personal care composition. Although the '115 patent discloses that the silicone emulsion can be used as a lipstick, this is merely a passing reference at column 14, lines 25-53, which also teaches a wide variety of other uses, e.g., hairsprays, pomades, household care products, automotive care products, shaving creams, insect repellants, etc. In these cases, the disclosed silicone emulsions "contain a variety of other ingredients". The '115 patent provides no apparent reason to select a lipstick from this list of end uses.

The examiner refers to sulfur-linked silicone containing copolymers at columns 19-21 of the '115 patent. These sulfur-linked silicone copolymers differ from a *silicone* modified fluorinated polymer. In particular, the '115 patent discloses *silicone* polymers that are modified with fluoroalkyl. Claim 17 recites a *fluorinated* polymer modified with a silicone, and does not recite sulfur-linking. Accordingly, because the '115 patent discloses silicone polymer different from the claimed fluorinated polymer, the

combination of references fails to teach every claimed element. A combination of the '115, '878, and '718 patents therefore cannot render claim 17 obvious under 35 U.S.C. §103. In addition, claim 24 is patentable over the combination of references for the same reason claim 17 is patentable.

With respect to claim 16, component (II) recites a polymeric vegetable oil emollient, e.g., sucrose polyester (claim 23). The '115 patent fails to teach or suggest a polymeric vegetable oil emollient, and therefore the combination of references fail to teach every claimed element and cannot render claims 15 and 23 obvious under 35 U.S.C. §103.

For all the reasons set forth above, it is submitted that claims 16 and 17, and new claims 23 and 24, would not have been obvious over a combination of the '115, '878, and '718 patents, and that the rejection should be withdrawn.

It is submitted that the claims are in proper form and scope for allowance. An early and favorable action on the merits is respectfully requested.

Should the examiner wish to discuss the foregoing, or any matter of form in an effort to advance this application toward allowance, the examiner is urged to telephone the undersigned at the indicated number.

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Respectfully submitted,

By 

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